

REMARKS

The Official Action mailed June 23, 2008, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes the *partial* consideration of the Information Disclosure Statement filed on March 29, 2006. Specifically, it appears that the Examiner inadvertently overlooked the citation of the "International Search Report of November 22, 2004 for PCT/JP2004/014762." A copy of the partially considered Form PTO-1449 is available in the Image File Wrapper under the heading, "List of References cited by applicant and considered by examiner" (2 pages) and has a mail room date of "06-23-2008." The Applicant respectfully requests that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of the above-referenced "International Search Report."

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on October 17, 2006; and March 3, 2008.

A further Information Disclosure Statement was filed on August 28, 2008 (received by OIPE September 2, 2008), and consideration of this Information Disclosure Statement is respectfully requested.

Claims 1-4, 6, 7, 9-12, 18 and 21 were pending in the present application prior to the above amendment. The features of dependent claim 6 have been incorporated into independent claims 1 and 21. Also, claims 11 and 12 have been amended to better recite the features of the present invention. Claim 18 has been canceled without prejudice or disclaimer. Accordingly, claims 1-4, 7, 9-12 and 21 are now pending in the present application, of which claims 1 and 21 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 1 of the Official Action rejects claim 18 under 35 U.S.C. § 101. Claim 18 has been canceled without prejudice or disclaimer; therefore, the above-referenced rejection is now moot.

Paragraph 2 of the Official Action rejects claims 11 and 12 under 35 U.S.C. § 112, second paragraph, asserting that the claims are "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention" (page 3, Paper No. 20080617). Specifically, regarding "the phrase[s] 'in the case' and 'when the route pattern edition unit executes addition of a destination,'" the Official Action asserts that "[i]t is unclear whether these limitations are optional and the occurrences of the above limitation or part of the invention" (*Id.*). In response, claim 11 has been amended to delete "in the case" and claim 12 has been amended to delete "when the route pattern edition means executes addition of a destination." Also, claims 11 and 12 have been amended to better recite the features of the present invention as noted in detail above.

The Applicant respectfully submits that claims 11 and 12 particularly point out and distinctly claim the subject matter which applicant regards as the invention. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112 are in order and respectfully requested.

Paragraph 4 of the Official Action rejects claims 1-4, 6, 7, 9-12, 18 and 21 as anticipated by EP 1 106 968 to Mannesmann. The Applicant respectfully traverses the rejection because the Official Action has not established an anticipation rejection.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Applicant respectfully submits that an anticipation rejection cannot be maintained against the independent claims of the present application. Independent claims 1 and 21 have been amended to include the features of previously dependent

claim 6. Specifically, claim 1 has been amended to recite a route pattern edition unit, for route patterns in which destinations are judged as satisfying the destination conditions by the judgment unit, any one of addition of destinations, deletion of destinations, change of destinations, and rearrangement of destinations as correction of the route patterns and causing the judgment unit to judge whether destinations in the route patterns after the correction satisfy the destination conditions. Claim 21 has been amended in a similar manner except that claim 21 recites "a route pattern edition unit" instead of "editing a route pattern" and "judgment unit" instead of "judging step." For the reasons provided below, the Applicant respectfully submits that Mannesmann does not teach the above-referenced features of the present invention, either explicitly or inherently.

In the Official Action, rather than setting forth statements which clearly set forth how the prior art reference teaches all the features of previously pending claim 6, either explicitly or inherently, the Official Action instead merely reproduces Applicant's claim 6 and adds a parenthetical notation, i.e. "paragraph 0017," without further comment or explanation (page 6, Paper No. 20080617). However, the Applicant respectfully submits that the Official Action fails to set forth how Mannesmann necessarily teaches at least the above-referenced features of claims 1 and 21, either explicitly or inherently. Further, the Applicant respectfully submits that Mannesmann does not, in fact, teach at least the above-referenced features.

Since Mannesmann does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

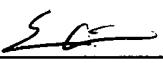
Paragraph 6 of the Official Action rejects dependent claims 7 and 9 as obvious based on the combination of Mannesmann and U.S. Publication No. 2001/0029429 to Katayama. The Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Please incorporate the arguments above with respect to the deficiencies in Mannesmann. Katayama does not cure the deficiencies in Mannesmann. The Official Action relies on Katayama to allegedly teach the features of dependent claims 7 and 9. However, Mannesmann and Katayama, either alone or in combination, do not teach or suggest that Mannesmann should be modified to include at least the above-referenced features of amended independent claims 1 and 21. Since Mannesmann and Katayama do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,


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